

**REMARKS**

This Application has been reviewed carefully in light of the Office Action mailed March 24, 2005 (“*Office Action*”). Claims 1-14 were pending in the Application and stand rejected. Applicant respectfully requests reconsideration and favorable action in this case.

**Claim Rejections – 35 U.S.C. § 102**

The Examiner rejects Claims 1 and 7 under 35 U.S.C. § 102(b) as anticipated by U.S. Patent No. 4,860,375, issued to McCubbrey et al. (“*McCubbrey*”). To anticipate a claim, a single prior art reference must teach, either expressly or inherently, each and every element of the claim. M.P.E.P. § 2131.

Applicant’s Claim 1 recites:

A method, comprising the steps of:  
providing a set of predetermined function definitions which are different, at least one of said predetermined function definitions defining a function for editing image data;  
storing a project definition that is operable when executed to edit said image data and which includes: a plurality of function portions which each correspond to one of said function definitions in said set, and which each define at least one input port and at least one output port that are functionally related according to the corresponding function definition; a further portion which includes a source portion identifying a data source and defining an output port through which said image data from the data source can be produced, and which includes a destination portion identifying a data destination and defining an input port through which said image data can be supplied to the data destination; and binding information which includes binding portions that each associate a respective said input port with one of said output ports;  
executing said project definition; and  
automatically transmitting a communication to a remote device through a communication link after editing said image data during execution of said project definition.

Applicant respectfully submits that *McCubbrey* fails to teach every element of this claim.

Among other aspects of Claim 1, *McCubbrey* fails to describe “automatically transmitting a communication to a remote device through a communication link after editing said image data during execution of said project definition.” In analyzing this element, the

Office Action fails to mention or address the requirement that the automatic transmission is “a communication to a remote device.” Rather, the Office Action focuses on interactions between elements of a local processing device, which *McCubbery* discloses as a collection of elements “typically located in a general purpose digital computer.” *McCubbery*, Col. 4, lines 58-59. In addressing this aspect of Claim 1, the Office Action merely points to various interactions between the components in the computer of *McCubbery*.

Specifically, the Examiner cites to (a) a “pipeline data path 42” shown in Figure 2<sup>1</sup> of *McCubbery*; (b) a discussion regarding using one various paths to route pixel data between components (*McCubbery*, Col. 3, lines 6-10, 42-57); and (c) a discussion regarding buses and pipelines for routing data between components (*McCubbery*, Col. 5, line 44–Col. 6, line 2; Figure 2). However, Applicant respectfully submits that the interconnections and interactions between components of the computer in *McCubbery* fail to teach, either expressly or inherently, “automatically transmitting a communication to a remote device through a communication link after editing said image data during execution of said project definition.”

For at least this reason, Applicant respectfully submits that *McCubbery* fails to teach, either expressly or inherently, each and every element of Claim 1. For analogous reasons, Applicant respectfully submits that *McCubbery* fails to teach, either expressly or inherently, each and every element of Claim 7. Thus, for at least these reasons, Applicant respectfully requests the Examiner to reconsider and withdraw the rejection of Claims 1 and 7.

### **Claim Rejections – 35 U.S.C. § 103**

The Examiner rejects Claims 1-14 under 35 U.S.C. § 103(a) as unpatentable over Workflow Management Coalition the Workflow Reference Model, Hollingsworth D., TC00-1003, Jan. 95 (“*Hollingsworth*”) in view of U.S. Patent No. 5,907,837 issued to Ferrell, et al. (“*Ferrell*”). To establish obviousness of a claimed invention, all claim limitations must be taught or suggested by the prior art. M.P.E.P. § 2143.03. Applicant respectfully submits that the proposed *Hollingsworth-Ferrell* combination fails to teach or suggest every element of any of the claims.

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<sup>1</sup> While the Office Action identifies “42 in Fig. 1,” Applicant notes that reference number 42 of *McCubbery* refers to either a “pipeline data path 42” in Figure 2 or a “memory card 42” in Figure 3. Applicant addresses only the first instance of 42 - the pipeline data path.

### Independent Claims

Consider again Applicant's independent Claim 1, which recites:

A method, comprising the steps of:  
providing a set of predetermined function definitions which are different, at least one of said predetermined function definitions defining a function for editing image data;  
storing a project definition that is operable when executed to edit said image data and which includes: a plurality of function portions which each correspond to one of said function definitions in said set, and which each define at least one input port and at least one output port that are functionally related according to the corresponding function definition; a further portion which includes a source portion identifying a data source and defining an output port through which said image data from the data source can be produced, and which includes a destination portion identifying a data destination and defining an input port through which said image data can be supplied to the data destination; and binding information which includes binding portions that each associate a respective said input port with one of said output ports;  
executing said project definition; and  
automatically transmitting a communication to a remote device through a communication link after editing said image data during execution of said project definition.

Among other aspects of Claim 1, the proposed *Hollingsworth-Ferrell* combination fails to teach or suggest "automatically transmitting a communication to a remote device through a communication link after editing said image data during execution of said project definition." As teaching this element, the Examiner cites to various portions of *Ferrell*. In general, *Ferrell* discloses techniques for information retrieval and multimedia publishing. *Ferrell*, Col. 7, lines 5-12; 57-65. The Office Action points to portions of *Ferrell* that discuss general components and connections contemplated by *Ferrell*. *Office Action*, page 4 (referencing *Ferrell*, Col. 8, lines 53-67; Col. 10, lines 16-54). However, the referenced portions bear little to no recognizable relation to any of the elements of Claim 1, including the "automatically transmitting" element. Rather than teaching or suggesting any automatic transmissions, these portions of *Ferrell* discuss customer requested downloads. For example, *Ferrell* states:

A customer, such as customer 162, utilizes a customer workstation 182 and a runtime Viewer software component 202 to find and activate MPS titles, stored on the network 122, on a visual display at the workstation 182.

*Ferrell*, Col. 10, lines 30-33. These customer initiated viewings do not, however, teach or suggest “automatically transmitting a communication to a remote device through a communication link after editing said image data during execution of said project definition.” Therefore, *Hollingsworth* and *Ferrell*, whether taken alone or in combination, fail to teach or suggest all elements of Applicant’s Claim 1.

For at least these reasons, Applicant respectfully submits that *Hollingsworth* in view of *Ferrell* fails to teach or suggest every element of independent Claim 1. For analogous reasons, Applicant respectfully submits that the proposed *Hollingsworth-Ferrell* combination fails to teach or suggest every element of independent Claim 7. Claims 2-6, 11, and 12 depend from and therefore include all elements of independent Claim 1. Claims 8-10, 13, and 14 depend from and therefore include all elements of independent Claim 7. Thus, for at least these reasons, Applicant respectfully requests the Examiner to reconsider and withdraw the rejection of Claims 1-14.

### **Dependent Claims**

Various dependent claims present additional elements not described by *Hollingsworth* or *Ferrell*. Consider dependent Claim 11, which recites:

A method according to Claim 1, wherein transmitting said communication occurs after editing a predetermined number of images.

As teaching the elements of Claim 11, the Examiner first cites to Figure 2 in *Hollingsworth*. *Hollingsworth* is a workflow management specification, and Figure 2 of *Hollingsworth* illustrates that workflow “may involve the transfer of tasks between different vendors['] workflow products to enable different parts of the business process to be enacted on different platforms or sub-networks using particular products suited to that stage of the process.” *Hollingsworth*, page 9. The Examiner also cites to discussion in U.S. Patent No. 5,974,431, which issued to Iida (“*Iida*”). The referenced portions of *Iida* discuss enlarging or reducing vector graphic data and restructuring enlarged or reduced vector graphic data into image

graphic data. *Iida*, Col. 3, lines 31-35. However, Applicant respectfully submits that the transfer of tasks between platforms and the enlarging or reducing of vector graphic data, either alone or in combination, fail to teach or suggest “wherein transmitting said communication occurs after editing a predetermined number of images.” Moreover, Applicant respectfully requests clarification whether the Examiner intends to rely on the combination of *Hollingsworth*, *Ferrell*, and *Iida* for this rejection.

For at least these reasons, Applicant respectfully submits that *Hollingsworth* in view of *Iida* fails to teach or suggest each and every element of dependent Claim 11. Claim 13 includes similar limitations, and thus for analogous reasons, Applicant respectfully submits that *Hollingsworth* in view of *Iida* fails to teach or suggest each and every element of Claim 13. Therefore, for at least these reasons, Applicant respectfully requests the Examiner to reconsider and withdraw the rejection of dependent Claims 11 and 13.

Also consider dependent Claim 12, which recites:

A method according to Claim 1, wherein said communication identifies an occurrence of a predefined condition.

As teaching the elements of Claim 12, the Examiner again cites to Figure 2 in *Hollingsworth*. Again, however, Figure 2 merely illustrates that workflow “may involve the transfer of tasks between different vendors['] workflow products to enable different parts of the business process to be enacted on different platforms or sub-networks using particular products suited to that stage of the process.” *Hollingsworth*, page 9. Applicant respectfully submits that the transfer of tasks between platforms fails to teach or suggest “wherein said communication identifies an occurrence of a predefined condition.”

For at least these reasons, Applicant respectfully submits that *Hollingsworth* in view of *Iida* fails to teach or suggest each and every element of dependent Claim 12. Claim 14 includes similar limitations, and thus for analogous reasons, Applicant respectfully submits that the proposed *Hollingsworth-Ferrell* combination fails to teach or suggest each and every element of dependent Claim 14. Therefore, for at least these reasons, Applicant respectfully requests the Examiner to reconsider and withdraw the rejection of dependent Claims 12 and 14.

**The Proposed *Hollingsworth-Ferrell* Combination is Not Proper**

In addition, Applicant respectfully submits that Claims 1-14 are patentable over the proposed *Hollingsworth-Ferrell* combination because there is no teaching, suggestion, or motivation to combine or modify the teachings of *Hollingsworth* and *Ferrell* either in the references themselves or in the knowledge generally available to one of ordinary skill in the art.

The M.P.E.P. discusses the strict legal standard for combining or modifying references. As discussed in the M.P.E.P., “[o]bviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art” at the time of the invention. M.P.E.P. § 2143.01. “The mere fact that references can be combined or modified does not render the resultant combination [or modification] obvious unless the prior art also suggests the desirability of the combination” or modification. *Id.* (emphasis in original).

Governing Federal Circuit case law makes this strict legal standard even clearer. According to the Federal Circuit, “a showing of a suggestion, teaching, or motivation . . . is an ‘essential component of an obviousness holding.’ ” *Brown & Williamson Tobacco Corp. v. Philip Morris Inc.*, 229 F.3d 1120, 1124-25 (Fed. Cir. 2000) (quoting *C.R. Bard, Inc., v. M3 Systems, Inc.*, 157 F.3d 1340, 1352 (Fed. Cir. 1998)). Furthermore, while “evidence of a suggestion, teaching, or motivation . . . may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, the nature of the problem to be solved, . . . [t]he range of sources available . . . does not diminish the requirement for actual evidence.” *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999). Thus, it is a factual question that cannot be resolved on subjective belief and unknown authority, but must be based on objective evidence of record. See *In re Lee*, 277 F.3d 1338, 1343-44 (Fed. Cir. 2002). Indeed, the factual inquiry whether to combine or modify references must be thorough and searching. *McGinley v. Franklin Sports, Inc.*, 262 F.3d 1339, 1351-52 (Fed. Cir. 2001).

In the present case, the *Office Action* includes only a single statement addressing whether there is any teaching, suggestion, or motivation to combine modify the teachings of *Hollingsworth* and *Ferrell*, stating:

One would be motivated to apply the secondary reference's teachings because in doing so multiple user have available for retrieval image data in one of several formats including image data and document data or a combination thereof, wherein the common source library database may store any type of data which can be repeatedly used.

*Office Action*, page 5 (sic).

This statement, however, fails to explain why one of skill in the art would have been motivated to combine *Ferrell's* information retrieval and publishing system with *Hollingsworth's* workflow management system. Applicant respectfully submits that workflow management and online publication are non-analogous fields of endeavor, and that the vague statement provided in the Office Action fails to establish any motivation to combine these non-analogous references.

For this additional reason, Applicant respectfully submits that Claims 1-14 are allowable over *Hollingsworth* in view of *Ferrell*.

**CONCLUSION**

Applicant has made an earnest attempt to place the Application in condition for allowance. For the foregoing reasons, and for other reasons clearly apparent, Applicant respectfully requests full allowance of all pending claims. If the Examiner feels that a telephone conference or an interview would advance prosecution of the Application in any manner, the undersigned attorney for Applicant stands ready to conduct such a conference at the convenience of the Examiner.

The Commissioner is hereby authorized to charge any fees or credit any overpayments to Deposit Account No. 02-0384 of BAKER BOTTS L.L.P.

Respectfully submitted,

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